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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,229	09/17/1999	JONATHAN J. HULL	74451.P100	9798
7590 02/06/2008 MICHAEL J MALLIE BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 900251026			EXAMINER' BOUTAH, ALINA A	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 02/06/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/398,229

Applicant(s)

HULL ET AL.

Examiner

Alina N. Boutah

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-28,33-36 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-28,33-36 and 38-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/29/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to Applicant's amendment filed October 31, 2007. Claims 17-28, 33-36 and 38-45 are pending in the present application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on October 29, 2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 22, 28, 33-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (U.S. Patent No. 5,848,413) in view of Gormish (U.S. Patent No. 5,692,048) in view of Epstein (U.S. Patent No. 6,584,508), in view of Matsui (U.S. Patent No. 6,742,116)), in further view of Dozier (U.S. Patent No. 5,870,552).

In considering claims 17, 22, and 28, Wolff discloses a system for publishing electronic documents on a network (see. Fig 7) comprising:

a multifunction machine to supply multiple electronic documents (see Wolff col. 7, lines 29-30);

While Wolff discloses a multifunction machine for use in publishing documents on the Web, Wolff does not explicitly disclose wherein the multifunction machine saves the electronic documents in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents.

Nonetheless, multifunction machines that performs user specified functions as wells as saving documents in the absence of an explicit command are well known as evidenced by Gormish.

In similar art Gormish discloses a fax machine that automatically saves a certain number of faxes (See Gormish col. 1, lines 46-49). It would have been obvious to a person having ordinary skill in the art to modify the system as disclosed by Wolff to include the automatic archiving feature so that documents could be stored and filed without user intervention thereby

reducing time, costs, and error while providing for future search and retrieval of the documents. Therefore, the aforementioned limitations as they appear in claims 1, 14, 17, 22, and 28, above would have been obvious from the explicit teachings of Gormish.

While Wolff discloses a gateway server that receives faxed images and transforms the images into documents for publication (See Wolff col. 7, lines 40-49), Wolff does not explicitly disclose wherein the gateway includes a content-based filter to transform one or more of the electronic documents to meet predetermined format and content based standards for publication over a network if one or more electronic documents do not meet the standards for publication.

Nonetheless, a content-based filter that translates, modifies, and transforms documents or files for publication is well known in the art as evidenced by Epstein. In similar art Epstein discloses a content-based filter that performs any necessary content-based decision-making and modifies the files by performing sanitation (e.g., excising profanity or 'fizzing' data values (see Epstein col. 9, lines 7-21) as well as converting file into standard format (figures 6A and 6B, col. 9, line 56 to col. 10, line 5). It would have been obvious to a person having ordinary skill in the art to modify the gateway server disclosed by Wolff to include the content based filter as disclosed by Epstein in order to ensure that documents are reviewed prior to publications so that undesired information is not published over the network. Therefore, the aforementioned limitations as they appear in claims 1, 14, 17, 22, and 28, above would have been obvious from the explicit teachings of Epstein.

While Wolff further discloses a server coupled to the filter, the server having a memory to store the electronic documents, the server permitting access to the electronic documents using a documents identifier (See Wolff col. 7, line 40-67 through col. 8, line 3; figure 7); Wolff does

not explicitly disclose authorization information to one or more recipients, the authorization information to enable the one or more recipients to access one or more of the subset of electronic documents. Nonetheless, a server that transmits authorization information to one or more recipients, the authorization information to enable the one or more recipients to access restricted information is well known as evidenced by Matsui. In similar art, Matsui discloses a server that creates new passwords (authorization information) and transmits the new passwords to each user terminals to enable access to a restricted area (col. 18, lines 47-52).

It would have been obvious to a person having ordinary skill in the art to modify the system as disclosed by Wolff to include the step of the server permitting access to the electronic documents using a documents identifier as well as server transmitted authorization information in order to prevent unauthorized access to the electronic documents by only allowing invited users or those users that have received authorization information from the server. This security feature would also be advantageous in preventing the electronic documents from being retrieved by tm welcome users. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Wolff.

Wolff does not explicitly teach wherein the server, automatically and in association with publication, causes the document identifier to be transmitted to one or more independent World Wide Web indexing services. Nonetheless, this feature is known in the art. In an analogous art, Dozier teaches a server that automatically causes the document identifier to be transmitted to one or more independent World Wide Web indexing services (abstract, col. 14, line 65 to col. 15, line 2; col. 16, lines 33-44). At the time the invention was made, one of ordinary skill in the art

would have been motivated to transmit document identifier to independent World Wide Web indexing services in order to facilitate search engine in retrieving specific web documents.

In considering claims 30, 33-36, while the combined system of Wolff, Gormish, Epstein, and Matsui discloses a content based filter that performs sanitation (e.g. removing profanity), the system does not disclose removing confidential, pornographic, or violent material from one or more selected electronic documents. Nonetheless, Examiner takes official notice that one having ordinary skill in the art would have readily recognized the uses and advantages of additionally removing confidential, pornographic, or violent material if the one or more selected documents contain confidential, pornographic, or violent information to ensure that documents intended for publication do not include undesired information.

In considering claims 38-39, 41-42, and 44-45 Wolff further discloses wherein the document identifier comprises a Universal Resource Locator (URL) corresponding to a published electronic document (See Wolff col. 7, lines 55-60).

In considering claims 40, and 43, the combined system of Wolff, Gormish, Epstein, and Matsui further discloses wherein the authorization information comprises a user name and a password sent to an authorized user (see Matsui col. 18, lines 47-57).

Claims 18, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff, Gormish, Epstein, Matsui and Dozier, in further view of Bauer (U.S. Patent No. 6,188,673 hereinafter Bauer).

In considering claims 18 and 23, Wolff disclose a system further comprising the network identifier comprises a Universal Resource Locator) has been sent from the server (See Wolff col. 7, lines 55-62).

In considering claim 27, although the system taught by Wolff discloses substantial features of the claimed invention it fails to disclose wherein the server generates a security key. However Wolff does disclose wherein the server allows access to the documents by creating an identifier/locator for the documents. Thus, a person having ordinary skill in the art would have recognized the desirability generating a security key as well ms an identifier so that the server would not only allow access to the documents, but also authorized access to the documents. Therefore, the claimed limitation would have been an obvious modification to the system taught by Wolff.

Claims 19-21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff, Gormish, Epstein, Matsui and Dozier, in further view of Skarbo et al. (U.S. Patent No. 6,3177,777 hereinafter, Skarbo).

In considering claims 19-21, and 24-26, although the combined system of Wolff and

Bauer discloses substantial features of the claimed invention, it fails to disclose wherein the server deletes or prevents access to the documents based on certain conditions. The conditions being when an authorized user accesses the documents after the documents has been stored on the server for a predetermined amount of time, or if the documents had been accessed a predetermined number of times. Nonetheless, the auto-deletion of documents based on certain conditions is well known as evidenced by Skarbo. In similar art Skarbo discloses a system and method for web based storage and retrieval of documents wherein administrative options may be set pertaining to documents such as the auto-deletion after n days, displaying user access rates, and resources used (col. 7, lines 9-18).

Thus given the teachings of Skarbo a person having ordinary skill in the art would have recognized the desirability to modify the combined system of Wolff and Bauer to include the maintenance options, described above, so that the publisher of the documents would have control over the documents' accessibility. Therefore, the claimed limitations would have been obvious modifications to the combined system of Wolff and Bauer.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In response to Applicant's argument that the references do not teach causing the document identifier to be transmitted to one or more independent World Wide Web indexing services, the PTO respectfully disagrees and submits that this is taught by Dozier combined with the rest of the references as cited above. Col. 16, lines 33-44 of Dozier discloses that the WAN document referenced in a database may preferably be located in anywhere in the WAN. The WAN-

compatible URL need not store locally. It is also noted that multiple indexing views and forms covering the same documents are possible. The fact that it is stored anywhere in WAN implies that it is its indexing service is independent.

In response to Applicant's argument that Epstein do not disclose format-and content-based standards transformation of documents, the PTO submits that this is taught in figures 6A and 6B as well as their corresponding description in col. 9, line 56 to col. 10, line 5 of Epstein. Specifically, the cited area discloses converting a file into a standard format as well as content-based standard.

Conclusion

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider the entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and non-preferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PT0-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The

Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read "Alina Boutah". The signature is written in a cursive, flowing style.

Alina Boutah
Patent Examiner
AU 2143